



UTILITY PATENT

B&D No. TN-2547

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: **Craig A. SCHELL et al.**

Serial No.: 10/057,476

Examiner: **L. Tran**

Filed: **January 24, 2002**

Group Art Unit: 3724

For: **FASTENER TOOL**

Assistant Commissioner for Patents
Washington, DC 20231

APPEAL BRIEF

I, Adan Ayala, Reg. No. 38,373, certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 5, 2004

Adan Ayala

RECEIVED
MAR 10 2004
TECHNOLOGY CENTER R3700

03/09/2004 AWONDAF1 00000144 022548 10057476

01 FC:1402 330.00 DA

TABLE OF CONTENTS

	<u>Page No.</u>
I. INTRODUCTION	1
II. REAL PARTY INTEREST	2
III. RELATED APPEALS AND INTERFERENCES	2
IV. STATUS OF CLAIMS	2
V. STATUS OF AMENDMENTS	2
VI. SUMMARY OF INVENTION	3
VII. ISSUE	4
VIII. GROUPING OF CLAIMS	4
IX. ARGUMENT	4
Claim 3 is Patentable under 35 USC § 103(a) over Fa in View of Foster.	4
X. APPENDIX	8
XI. CONCLUSION	8
XII. FEES	8

UTILITY PATENT

B&D No. TN-2547

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: **Craig A. SCHELL et al.**

Serial No.: **10/057,476**

Examiner: **L. Tran**

Filed: **January 24, 2002**

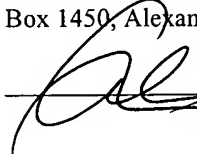
Group Art Unit: **3724**

For: **FASTENER TOOL**

Assistant Commissioner for Patents
Washington, DC 20231

APPEAL BRIEF

I, Adan Ayala, Reg. No. 38,373, certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 5, 2004



Adan Ayala

Dear Sir:

I. INTRODUCTION

In response to the Final Office Action mailed November 14, 2004, a Notice of Appeal was mailed on January 13, 2004, for the above-identified application. The present appeal brief is being timely filed, as required under 37 CFR § 1.192.

II. REAL PARTY IN INTEREST

The real party in interest in the present case is Black & Decker Inc. An assignment transferring all rights to the present application and resulting patents was filed in the prior provisional application. The assignment was recorded on February 1, 2002, and can be found at Reel 12558, Frame 0091.

III. RELATED APPEALS AND INTERFERENCES

No other appeals or interferences related to the present case are currently pending.

IV. STATUS OF CLAIMS

Claims 1-32 have been considered throughout the prosecution history of the present application. Claims 4-6 were previously canceled. Claims 1-2 and 7-32 have been withdrawn from consideration pursuant to restriction requirements. Claim 3 is currently pending and is hereby appealed.

V. STATUS OF AMENDMENTS

No amendment was filed in response to the Final Office Action.

VI. SUMMARY OF INVENTION

Pursuant to 37 CFR § 1.192 and MPEP § 1206, Applicant/appellant hereby provides a concise explanation of the inventions defined in the claims involved in the present appeal. This explanation refer to the specification by page and line number and to the drawings, as required by the CFR and the MPEP rules. However, the following explanation only refers to the preferred embodiment disclosed in the specification and does not discuss alternative mechanisms that would be covered by the claims. Accordingly, the following explanation should not be used to limit the scope of the claims.

Independent Claim 3 calls for a fastener tool comprising a housing 15 (spec., p. 5, lns.6-7), a magazine 40 connected to the housing 15 for storing a fastener (spec., p. 5, lns. 9-10), a driving mechanism disposed within the housing 15 for driving the fastener into a workpiece (spec., p. 5, lns. 6-8), and a contact trip assembly 23 slidably mounted to the housing 15 and movable when a user pushes the housing towards the workpiece (see spec., p. 6, lns. 3-4). In addition, a trigger assembly 20 is pivotally attached to the housing 15 for activating the driving mechanism. Spec. p. 5, lns. 10-11. The trigger assembly 20 is rotatable relative to the housing 15 about a first axis. See spec., p. 6, lns. 5-6. The trigger assembly 20 comprises a main trigger 21 pivotally attached to the housing 15, and a supplemental trigger 22 pivotally attached to the main trigger 21. Spec., p. 5, lns. 16-18. The supplemental trigger 22 is movable by the contact trip assembly 23. Spec., p. 6, lns. 6-7. The driving mechanism is activated only when the user rotates the main trigger 21 and the contact trip assembly 23 moves the supplemental trigger 22. Spec., p. 6, lns. 6-9.

UTILITY PATENT

B&D No. TN-2547

In addition, a trigger lock 26 disposed between the housing 10 and the trigger assembly 20. See spec., p. 8, lns. 16-17. The trigger lock 26 is rotatable about a second axis substantially perpendicular to the first axis (see. FIG. 4) between a first position limiting the pivoting range of the trigger assembly 20 relative to the housing 10 for preventing the trigger assembly 20 from activating the driving mechanism (spec., p. 8, lns 14-19), and a second position not preventing the trigger assembly 20 from activating the driving mechanism (spec., p. 8, lns. 20-21). The trigger lock 26 has a handle 26T for moving the trigger lock 26 between the first and second positions. Spec., p. 8, lns. 22-23. This handle 26T is rotatable with the trigger lock 20 about the second axis. See FIG. 4.

VII. ISSUE

Whether Claims 3 is unpatentable under 35 USC § 103(a) over US Patent No. 5,785,228 (“Fa”) in view of US Patent No. 5,823,395 (“Foster”).

VIII. GROUPING OF CLAIMS

For the rejection under 35 USC §103(a), Claim 3 stands by itself.

IX. ARGUMENT

Claim 3 is Patentable under 35 USC § 103(a) over Fa in View of Foster.

The Board should reverse the Examiner’s improper final rejection of Claim under 35 USC § 103(a) based on Fa in view of Foster. In particular, the Examiner erred in using Foster as a prior

art reference as Foster is not analogous to the fastener tool field. Therefore, the Examiner's rejection was improper and should be reversed.

Independent Claim 3, as amended, calls for a fastener tool comprising a housing, a magazine connected to the housing for storing a fastener, a driving mechanism disposed within the housing for driving the fastener into a workpiece, a contact trip assembly slidably mounted to the housing and movable when a user pushes the housing towards the workpiece, a trigger assembly pivotally attached to the housing for activating the driving mechanism, the trigger assembly being rotatable relative to the housing about a first axis, the trigger assembly comprising a main trigger pivotally attached to the housing, and a supplemental trigger pivotally attached to the main trigger, the supplemental trigger being movable by the contact trip assembly, the driving mechanism being activated only when the user rotates the main trigger and the contact trip assembly moves the supplemental trigger, and a trigger lock being rotatable about a second axis substantially perpendicular to the first axis between a first position limiting the pivoting range of the trigger assembly relative to the housing for preventing the trigger assembly from activating the driving mechanism, and a second position not preventing the trigger assembly from activating the driving mechanism position, the trigger lock having a handle for moving the trigger lock between the first and second positions, the handle being rotatable with the trigger lock about the second axis.

Admittedly, Fa shows for a fastener tool comprising a housing, a magazine connected to the housing for storing a fastener, a driving mechanism disposed within the housing for driving the fastener into a workpiece, a trigger assembly pivotally attached to the housing for activating the driving mechanism, the trigger assembly being rotatable relative to the housing about a first axis.

However, Fa does not show a fastener tool with a trigger lock disposed between the housing and the trigger assembly movable between a first position limiting the pivoting range of the trigger assembly relative to the housing for preventing the trigger assembly from activating the driving mechanism, and a second position not preventing the trigger assembly from activating the driving mechanism position, and the trigger lock having a handle for moving the trigger lock between the first and second positions.

By contradistinction, Claim 3 calls for (a) “a trigger lock disposed between the housing and the trigger assembly,” (b) “the trigger lock being rotatable about a second axis substantially perpendicular to the first axis between a first position limiting the pivoting range of the trigger assembly relative to the housing for preventing the trigger assembly from activating the driving mechanism, and a second position not preventing the trigger assembly from activating the driving mechanism position,” and (c) “the trigger lock having a handle for moving the trigger lock between the first and second positions, said handle being rotatable with the trigger lock about the second axis.”

To provide such elements, the Examiner relies on Foster, which relates to “manually operated pump dispensers.” Foster, col. 1, lns. 4-5. However, the Examiner cannot combine Fa with Foster because Foster is not analogous art.

Foster is not analogous art because a person of ordinary skill in the fastener tool arts would not look in the pump dispenser field for a solution. “In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which

the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

Oetiker provides a good example of what can be considered analogous prior art in the mechanical arts, which include the present invention. In *Oetiker*, the applicant claimed an improvement in a hose clamp which differed from the prior art in the presence of a preassembly "hook" which maintained the preassembly condition of the clamp and disengaged automatically when the clamp was tightened. The Board relied upon a reference which disclosed a hook and eye fastener for use in garments, reasoning that all hooking problems are analogous. The CAFC held the reference was not within the field of applicant's endeavor, and was not reasonably pertinent to the particular problem with which the inventor was concerned because it had not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments.

Similarly, the Examiner has provided no evidence that a person of ordinary skill, seeking to solve a problem of preventing unintended triggering of the fastener tool by an adult, would reasonably be expected or motivated to look for a solution in the child-proof pump dispenser field. Such failure is significant as Applicants/appellant specifically requested such evidence in a prior response to an Office Action.

Instead of providing evidence, the Examiner just stated "Foster et al. is certainly reasonably pertinent to the problem of specific trigger lock designs." This rationale contradicts *Oetiker*. Just like the PTO was not allowed to bring in hooks from the garment fastening field into the hose clamp fastening field, the Examiner should not be allowed to bring in child-proof

UTILITY PATENT

B&D No. TN-2547

pumps from the pump dispenser field into the fastener tool field, especially where the Examiner has not provided any evidence that a person of ordinary skill would look in the pump dispenser bailing field.

X. APPENDIX

An appendix attached hereto contains a copy of the claim involved in the appeal.

XI. CONCLUSION

Based on the foregoing, Applicants/appellant urges the Board to reverse the Examiner's final rejection of Claim 3 under 35 USC § 103(a). Furthermore, the Board should order the allowance of Claim 3.

XII. FEES

The Commissioner is authorized to charge payment of the appeal brief filing fee (\$330.00), as well as any other fees due in processing this amendment, or credit any overpayment to Deposit Account No. 02-2548.

Respectfully submitted,



Adan Ayala
PTO Reg. No. 38,373
Attorney for Applicant/appellant

Appendix attached



APPENDIX

3. A fastener tool comprising:

a housing;

a magazine connected to the housing for storing a fastener;

a driving mechanism disposed within the housing for driving the fastener into workpiece;

a contact trip assembly slidably mounted to the housing and movable when a user pushes the housing towards the workpiece;

a trigger assembly pivotally attached to the housing for activating the driving mechanism, said trigger assembly being rotatable relative to the housing about a first axis, said trigger assembly comprising a main trigger pivotally attached to the housing, and a supplemental trigger pivotally attached to the main trigger, said supplemental trigger being movable by the contact trip assembly, said driving mechanism being activated only when the user rotates the main trigger and the contact trip assembly moves the supplemental trigger; and

a trigger lock disposed between the housing and the trigger assembly, the trigger lock being rotatable about a second axis substantially perpendicular to the first axis between a first position limiting the pivoting range of the trigger assembly relative to the housing for preventing the trigger assembly from activating the driving mechanism, and a second position not preventing the trigger assembly from activating the driving mechanism position, the trigger lock having a handle for moving the trigger lock between the first and second positions, said handle being rotatable with the trigger lock about the second axis.

RECEIVED
MAR 10 2004
TECHNOLOGY CENTER R3700